



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,437	10/15/2001	Jeffrey A. Heroux	2528-8	3932
22852 7590 08/07/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER CHUNDURU, SURYAPRABHA	
			ART UNIT 1637	PAPER NUMBER
			MAIL DATE 08/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/976,437	Applicant(s) HEROUX ET AL.	
	Examiner Suryaprabha Chunduru	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-47, 50-57, 60-67, 69, 77-87 and 90-94 is/are pending in the application.
- 4a) Of the above claim(s) 77-80 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 55-57, 60-64, 83, 84 and 92-94 is/are allowed.
- 6) ☒ Claim(s) 45-47, 50-53, 65-67, 81, 82, 85-87, 90 and 91 is/are rejected.
- 7) ☒ Claim(s) 54 and 69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Upon considering the issues raised by the Attorney on the record, John Marquardt on August 01, 2007 in a telephonic interview, regarding the status of the pending claims, the last office action is withdrawn and vacated herein and the following supplemental action is set forth herein.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 20, 2007 has been entered.

Status of the Application

3. The action is in response to the RCE filed on June 20, 2007. Currently claims 45-47, 50-57, 60-67, 69, 81-87, 90-94 are pending. Claims 1-44, 48-49, 58-59, 68, 70-76 and 88-89 are cancelled. Claims 77-80 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group. All arguments and amendment have been fully considered and thoroughly reviewed and deemed persuasive for the reasons that follow.

Sequence Rules and Objection to the Specification

4. The specification is objected because of the following informalities:
 - (i) This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply the requirements of 37 CFR 1.821 through 1.825.

The instant application recites sequences that are not identified by SEQ ID No. (see at least page 37 and 40) recite a nucleic acid sequence / amino acid sequence with more than 10 nucleotides or 4 amino acids, which is not identified by SEQ ID NO.). Examiner also notes that the application contains no sequence listing either in the form of a paper copy or in a computer readable form. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 45-47, 50-53, 65-67, 81-82, 85-87, 90-91 are rejected under 35 U.S.C. 102(a) as being anticipated by Wohlstadter et al. (WO 98/12539).

Wohlstadter et al. teach a method of claim 45-47, 50-51, 90-91, of assaying a sample for an enzyme activity that joins a first substrate (binding domain) with a second substrate (binding domain) comprising (a & b) forming a composition comprising said sample, said first and second substrate and incubating said composition to form a product (see page 21, line 1-5); (c) immobilizing a luminescent label on an electrode wherein the label is linked to said product formed (see page 21, line 3-6, line 9-18, page 71, line 5-36); (d) applying a voltage at said electrode so as to induce luminescent label to emit luminescence (see page 21, line 6-8, line 18-20); (e) measuring emitted luminescence so as to measure the presence of said enzyme or factor in said sample (see page 21, line 8, 20-30, indicating measuring analytes in various

concentrations, said analytes include enzymes or factors (see page 41, line 29-37, page 42, line 1-32, page 45, line 27-37).

With regard to claim 46, Wohlstadter et al. teach that the luminescent label is linked to the first substrate and second substrate is linked to an electrode (see page 21, line 9-21, page 15, line 18-29).

With regard to claim 50, Wohlstadter et al. teach that said first substrate is linked to a luminescent label and said second substrate is linked to a capture moiety (capture moiety the binds to the luminescent label) (see page 22, line 19-35, page 15, line 30-34).

With regard to claim 52-53, 81-82, Wohlstadter et al. teach that said first and second substrates are nucleic acids, complementary nucleic acid pairs proteins antibody/hapten pair, streptavidin-biotin (see page 68, line 19-29, line 2-page 15, line 25-34).

With regard to claims 65-67, Wohlstadter et al. teach that said electrode comprises elemental carbon in the form of carbon black and said electrode comprises conductive particles dispersed within or polymeric material (see page 83, line 35-37, page 84, line 1-9, page 76, line 1-37, page 77, line 1-35, page 55, line 36-37, page 56, line 1-2).

With regard to claim 85-86, Wohlstadter et al. teach that said electrode comprises metal , wherein the metal is gold (see page 55, line 27-35, page 70, line 8-32).

With regard to claim 87, Wohlstadter et al. teach that said factor is an enzyme, inhibitors, co-enzyme (see page 94, line 15-37). Accordingly Wohlstadter et al. anticipates the instant claims.

Response to arguments:

6. With regard to the rejection of claims 45-67, 69, 81-87 and 89 under 35 USC 103(a) as being obvious over Shukla et al. in view of Massey et al., Applicants' arguments and amendment are fully considered and found persuasive and the rejection is withdrawn in view of the amendment.

Allowable Subject Matter

7. Claims 54, 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 55-57, 60-64, 83-84, and 92-94 are allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M , Mon - Friday,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 09/976,437
Art Unit: 1637

Page 6

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Suryaprabha Chunduru
Primary Examiner, Art Unit 1637

Suryaprabha Chunduru
SURYAPRABHA CHUNDURU 8/2/07
PRIMARY EXAMINER